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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,087	03/25/2004	Gerd M. Ritter	15609-030001/2004P00043	7663
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FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER LEWIS, ALICIA M	
			ART UNIT	PAPER NUMBER
			2164	

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,087

Applicant(s)

RITTER ET AL.

Examiner

Alicia M. Lewis

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on July 30, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 6 contradicts the limitations of claim 1. Claim 1 recites the limitation of retrieving search results, each search result containing the name identifier and specified relationship to the name identifier. Therefore, claim 6 is contradicting claim 1 by reciting an incidence of no search results containing the name identifier and the specified relationship to the name identifier.
5. Claim 10 recites the limitation "the first name identifier" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 20-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16 and 20-28 are not limited to tangible embodiments. A machine-readable medium may represent any number of things, depending on what the "machine" actually is. The term "machine-readable medium" is too ambiguous; as such, the claims are not limited to statutory subject matter and are therefore non-statutory. The examiner suggests that the applicant consider using the term "computer-readable medium". However, the medium must clearly be limited to tangible embodiments.

Claim 20 is further rejected as being an abstract idea, directed solely to non-functional descriptive material. The data structure represents instructions or information that is not being executed, thus the data structure is non-functional descriptive material and does not represent statutory subject matter. Claims 21-28 are further rejected as being dependent on claim 20.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

Art Unit: 2164

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Swan (US Patent Application Publication 2004/0093317 A1).

With respect to claims 1, 16 and 17, Swan teaches:

accepting input from a user to create a search request that contains a plurality of text characters, wherein one or more of the text characters specify a name identifier, and wherein one or more of the text characters specify a relationship to the name identifier (Figure 10, paragraphs 104, 117-121 and 127-128);

using the search request to retrieve search results, wherein each search result contains the name identifier, and wherein each search result also contains information representing the specified relationship to the name identifier (paragraph 123); and

displaying to the user the name identifier for each search result in textual form (Figure 11, paragraph 133).

Paragraphs 117-121 and 127-128 show various methods of inputting search criteria, in which relationships to a name identifier are included. Regarding Figure 10, Swan teaches a plurality of search criteria that may be entered. The following criteria may be used to specify a relationship to a name identifier (in this case, the contact's first name): the last name, email address, company name, address, city, state, zip, suite number, position, web address, fax number and telephone number.

With respect to claim 2, Swan teaches wherein the method further comprises displaying to the user information representing the specified relationship to the name identifier for each search result in textual form (Figure 11, paragraph 133).

With respect to claims 3 and 18, Swan teaches wherein the method comprises using the search request to retrieve search results from an external database system (Figures 1 and 2, paragraphs 81 and 83).

With respect to claim 4, Swan teaches wherein the external database system contains additional information (element 166 in Figure 5, paragraph 66).

With respect to claim 5 and 19, Swan teaches wherein the method comprises using the search request to retrieve search results from a memory (paragraphs 81 and 201).

With respect to claim 6, Swan teaches wherein if no search results contain the name identifier and information representing the specified relationship to the name identifier, the method comprises using the search request to retrieve search results that each contain the name identifier (paragraphs 104-105).

With respect to claim 7, Swan teaches wherein one or more of the text characters specify a second name identifier, and wherein the method comprises using

the search request to retrieve search results that each contain the second name identifier and information representing the specified relationship between the name identifier and the second name identifier (Figure 10, paragraphs 104, 117-121 and 127-128).

With respect to claim 8, Swan teaches wherein the second name identifier is a personal name identifier, wherein the specified relationship is a contact relationship, and wherein the name identifier is an organizational identifier (Figure 10, paragraphs 104 and 120-121).

With respect to claims 9 and 27, Swan teaches wherein one or more of the text characters specify a third name identifier, wherein one or more of the text characters specify a second relationship between the second name identifier and the third name identifier, and wherein the method comprises using the search request to retrieve search results that each contain the third name identifier and information representing the second specified relationship between the second name identifier and the third name identifier (Figure 10, paragraph 104, paragraphs 127-128).

With respect to claims 10 and 28, Swan teaches wherein one or more of the text characters specify a third name identifier, wherein one or more of the text characters specify a second relationship between the first name identifier and the third name identifier, and wherein the method comprises using the search request to retrieve

Art Unit: 2164

search results that each contain the third name identifier and information representing the second specified relationship between the first name identifier and the third name identifier (Figure 10, paragraph 104, paragraph 120 lines 3-4).

With respect to claim 11, Swan teaches wherein the third name identifier is a location name identifier, and wherein the second specified relationship is a location relationship (Figure 10, paragraph 104, paragraph 120 lines 3-4).

The city, Los Angeles, which represents a location relationship to the first identifier (Anderson), may be considered the third name identifier. In this case, Main may be considered the second name identifier. Also, Figure 10 shows several fields, including: address, city, state and zip, which may all be used as location name identifiers.

With respect to claims 12, 25 and 26, Swan teaches wherein the name identifier contains a wildcard character (paragraph 106).

With respect to claim 13, Swan teaches wherein the specified relationship is a working business relationship to the name identifier (Figure 10, paragraph 53, paragraph 120 lines 1-2).

With respect to claims 14 and 24, Swan teaches wherein the specified relationship is a location relationship to the name identifier (Figure 10, paragraph 120 lines 3-4).

With respect to claims 15 and 22, Swan teaches wherein the name identifier is a location name identifier, an organizational name identifier, or a personal name identifier (Figure 10, paragraphs 117, 120 and 127).

With respect to claim 20, Swan teaches:

a first name identifier having one or more text characters (Figure 10, paragraphs 117-121, 127-128);

a second name identifier having one or more text characters (Figure 10, paragraphs 117-121, 127-128); and

a relationship having one or more text characters and being used to specify a relationship between the first and second name identifiers (Figure 10, paragraphs 117-121, 127-128).

Paragraphs 117-121 and 127-128 show various methods of inputting search criteria, in which relationships to a first name identifier are included. Regarding Figure 10, Swan teaches a plurality of search criteria that may be entered. The following criteria may be used to specify a relationship to a first name identifier (in this case, the contact's first name): the last name, email address, company name, address, city, state, zip, suite number, position, web address, fax number and telephone number.

Art Unit: 2164

With respect to claim 21, Swan teaches wherein the first name identifier, the second name identifier, and the relationship are all provided in a single text-entry field (paragraphs 117-121, 127-128).

With respect to claim 23, Swan teaches wherein the second name identifier is a location name identifier, an organizational name identifier, or a personal name identifier (Figure 10, paragraphs 117, 120 and 127).


SAM RIMELL
PRIMARY EXAMINER